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EXAMINER

CHAMPAGNE, DONALD

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3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09853961
Filing Date: 10 May 2001
Appellant(s): BEYER ET AL.

MAILED

SEP 20 2007

GROUP 3600

John P. Wagner, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8 June 2007 appealing from the Office action mailed 11 August 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct, save the following typographical error: At the bottom of brief p. 6, the citation "Page 9 lines 1-24", actually precedes a quotation from page 9 lines 1-10 and 16-27, and page 10 lines 1-14.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Cannon, US006286005B1, 4 September 2001.

(9) Grounds of Rejection

Art Unit: 3622

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 11 August 2006.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-10 and 20-30 with an amendment filed on 8 May 2006 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-10 and 20-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Cannon (US006286005B1).
4. Cannon teaches (independent claims 1 and 20) a method of task selection and a computer system, the method comprising the steps of: determining an *actual* or *specified* advertising strategy (col. 3 line 63 and col., 50 lines 64-67), which reads on determining a specified distribution of a plurality of tasks/*ads* (e.g., said specified distribution being *ad spots A, B and C*, in the *Scoring Example*, col. 38 line 65 to col. 39 line 7); assuming a first event in a sequence of events occurs (a *viewing event*, col. 9 line 55, occurring at some arbitrary point in the future), each event in said sequence of events triggering execution of one of said plurality of tasks/*ads* (e.g. triggering exposure to one of the three or more *ad spots*, col. 39 lines 7-27 and Fig. 15); comparing various proposed ad strategies to the *actual/specified* ad strategy (col. 3 line 63, col. 13 lines 48-50 and Fig. 1, where the *advertising optimization mechanism* is labeled both **128** and **129** at various places, col. 28 lines 22-25, and col. 31 lines 16-23), which reads on determining a

plurality of hypothetical distributions of said plurality of tasks/*ads* for each task/*ad* hypothetically selected for execution from said plurality of tasks/*ads* (e.g., for the selected *ad spot* tasks *D*, *E*, *F* and *G*, col. 41 lines 54-57); selecting a first task/*ad* for execution from said plurality of tasks/*ads* (e.g., *ad spot* task *D*), which when selected provides a corresponding hypothetical distribution (*spots A*, *B*, *C* and *D*, col. 39 lines 3-13) of said plurality of tasks that is closest to said specified distribution (i.e., that which maximizes the score $S_c(a)$, col. 38 lines 21-64 and col. 41 lines 57-59) of said plurality of tasks for implementation of said specified distribution.

5. Cannon also teaches at the citations given above claims 6 and 25 ($S_c(a)$ is an inverse measure of mathematical distance), 7 and 26, 8 and 27 (the formula for $S_c(a)$, col. 38 lines 21-64, reads on a vector), and 9, 10, 29 and 30.
6. Cannon also teaches: claims 2, and 21 (col. 3 lines 53-59 and col. 32 lines 48-51); claims 3 and 22 (col. 6 lines 11-12); claims 5 and 24, with said plurality of components defining the amount (number) of times each of said plurality of tasks has been selected (col. 35 lines 8-9); and claim 28 (col. 31 line 44).
7. Cannon does not explicitly teach (claims 4 and 23) that said plurality of tasks/advertising promotions is offered individually to said sequence of viewers/customers. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Cannon does teach applying the invention to a web site, where it is inherent that said viewers/customers arrive in sequence, so said plurality of tasks/advertising promotions would have to be offered to said viewers/customers individually, in sequence.

(10) Response to Argument

Argument that claims 1-10 and 20-30 should not have been rejected under 35 U.S.C. 102(e) as being anticipated by Cannon

As a preliminary matter, system/apparatus claims 20-27, 29 and 30 are respectively very similar to method claims 1-10. The appellant argues in detail only for claim 1, and that is also the claim rejected in detail (para. 4 of the rejection duplicated above).

Claim 1 has four limiting steps. On pp. 12-16 inclusive, the appellant argues that Cannon does not teach each of these steps. However, it will be shown that the appellant's argument relies on reading limitations from the specification into the claim, a practice that is prohibited.¹

Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

The instant application contains no such "clear definition" for any of its terms. The application explains its terms by example only. See for example p. 6 of the brief, middle para., where the appellant has explained the terms "an event", "a task", "a segment" and "customer characteristics" only by example. By contrast, the examiner is required in the instant case to give terms their broadest reasonable interpretation.

First limitation of claim 1:

"determining a specified distribution of a plurality of tasks;"

The rejection of this limitation is as follows:

"determining an *actual* or *specified* advertising strategy (col. 3 line 63 and col., 50 lines 64-67), which reads on determining a specified distribution of a plurality of tasks/*ads* (e.g., said specified distribution being *ad spots A, B* and *C*, in the *Scoring Example*, col. 38 line 65 to col. 39 line 7);" (Para. 4 of the rejection mailed 11 August 2006)

Appellant argues (p. 12, bottom para.)

¹ "It is Improper to Import Claim Limitations from the Specification", MPEP § 2111.01.II.

“On the other hand, the Cannon reference does not disclose a specified distribution of a plurality of tasks. Instead, the Cannon reference teaches a method for selecting an additional spot for inclusion within an advertising schedule.”

The specification does not give “clear definition” to “a specified distribution of a plurality of tasks”, so appellant has no basis for the argument. Appellant’s statement of fact is correct - the Cannon reference does teach a method for selecting an additional spot for inclusion within an advertising schedule – but the examiner judges that that reads on the broadest reasonable interpretation of the claim limitation.

Second limitation of claim 1:

“assuming a first event in a sequence of events occurs, each event in said sequence of events triggering execution of one of said plurality of tasks;”

The rejection of this limitation is as follows:

“assuming a first event in a sequence of events occurs (a *viewing event*, col. 9 line 55, occurring at some arbitrary point in the future), each event in said sequence of events triggering execution of one of said plurality of tasks/*ads* (e.g. triggering exposure to one of the three or more *ad spots*, col. 39 lines 7-27 and Fig. 15);” (Para. 4 of the rejection mailed 11 August 2006)

Appellant explains this limitation with the following illustration,

“Further, independent Claims 1 and 20 each disclose that an event in a sequence of events is assumed to occur in order to determine which of the tasks is selected. Each event triggers execution of one of the plurality of tasks. The events as disclosed in the present embodiments describe single actions that trigger execution of one of the plurality of tasks (e.g., L, M, N, or O). For example, when a customer visits a web site as an event, the present embodiments of independent Claims 1 and 20 are able to determine which task (e.g., L, M, N, or O), or advertisement, is selected to present to the customer.” (Brief p. 13, first full para., emphasis added.)

Appellant then argues,

“On the other hand, the Cannon reference does not disclose the assumption of a single event in a sequence of events, wherein each event in the sequence triggers

execution of one of the plurality of tasks, as in the present invention. Instead, the Cannon reference utilizes a history of viewing data for a sample group to determine selection of one of the possible plurality of time spots (e.g., spots D, E, F, or G) for inclusion within the advertising schedule. Once one of the time spots (e.g., spots D, E, F, or G) is selected, the remaining possible time spots are never selected. That is, the Cannon reference teaches the selection of one spot in a plurality of possible time spots. As such, the Cannon reference teaches a history of viewing events that is used to select from one of a plurality of possible time spots (e.g., spots D, E, F, and G), but does not teach the assumption of an event in a sequence of events that triggers execution of one of a plurality of tasks, as is disclosed in independent Claims 1 and 20.” (Brief pp. 13-14)

Again, appellant and the examiner disagree because of differing interpretations of the claim terms. The examiner has given the terms their broadest reasonable interpretation: in this case, interpreting that the claimed “first event” as the *viewing event* taught by Cannon. Conversely, the appellant argues that the claimed “first event” should be interpreted as following example given in the specification:

“[0071] It is appreciated that process 500 in FIG. 5 can be utilized in any data driven environment where task selection is necessary in response to an event. In the above example, the event described is a visit by a customer to a web site over a communication network, such as the Internet.” (Para. [0071] of the published application, US 20020178052A1. Emphasis added.)

The appellant has read a limitation from the spec. into the claims. Furthermore, the specification itself suggests that this example is not the broadest reasonable interpretation:

“[0054] While the present invention is described in an environment where an advertising campaign is offered to customers visiting a web site over a communication network such as the Internet, it is appreciated that the present invention can be utilized in any data driven environment where a task, [sic] operation is performed, or a selection is made in response to an event.” (Para. [0054] of the published application, US 20020178052A1. Emphasis added.)

Third limitation of claim 1:

“determining a plurality of hypothetical distributions of said plurality of tasks for each task hypothetically selected for execution from said plurality of tasks;”

The rejection of this limitation is as follows:

“comparing various proposed ad strategies to the *actual/specified* ad strategy (col. 3 line 63, col. 13 lines 48-50 and Fig. 1, where the *advertising optimization mechanism* is labeled both **128** and **129** at various places, col. 28 lines 22-25, and col. 31 lines 16-23), which reads on determining a plurality of hypothetical distributions of said plurality of tasks/*ads* for each task/*ad* hypothetically selected for execution from said plurality of tasks/*ads* (e.g., for the selected *ad spot* tasks *D*, *E*, *F* and *G*, col. 41 lines 54-57);” (Para. 4 of the rejection mailed 11 August 2006)

Appellant argues,

“[Ref. A] On the other hand, the Cannon reference does not calculate a hypothetical distribution of the execution of the plurality of tasks.

[Ref. B] The Cannon reference teaches a scoring for each alternative spot (spots D, E, F, or G) using five indices that are considered in the advertising optimization process.

[Ref. C] However, embodiments of the present invention are distinguishable from the Cannon reference in that the scoring is determined from a singular plurality of tasks, and not from a multiple plurality of possible tasks. Specifically, embodiments of the present invention determine a hypothetical distribution from an unvarying, singular plurality of tasks (e.g., L, M, N, and O), whereas, the Cannon reference determines scores for multiple plurality of possible tasks. That is, the Cannon reference provides a score for the following four advertising schedules: spots A, B, C, and D; spots A, B, C, and E; spots A, B, C, and F; and spots A, B, C, and G. As such, the Cannon reference does not teach the determination of a plurality of hypothetical distributions of the singular and unvarying plurality of tasks, as is recited in independent Claims 1 and 20 of the present invention.” (Last para. on Brief p. 14. Emphasis added.)

First, in the first line [Ref. A], the claim is to “determining” distributions, not calculating distributions. The reference does teach determining distributions, as stated in the rejection.

Second [Ref. B], the appellant dismisses the reference as merely scoring each of four alternative spots. That is a grossly incomplete summary of the reference, and it ignores the rejection statement. According to the rejection, the reference teaches,

“Further, by utilizing the advertising optimization mechanism of the present invention, businesses, networks, and advertising agencies can interactively create, score, rank and compare various proposed or actual advertising strategies in a simple and efficient manner.” (Cannon, col. 3 lines 60-63)

“Comparing various proposed advertising strategies” reads on the claimed limitation, “determining a plurality of hypothetical distributions of said plurality of tasks for each task hypothetically selected for execution from said plurality of tasks”, where “task selected for execution” is interpreted as advertisements being/to be shown. Cannon illustrates the process with an example in which “spots” (advertisement showings) D, E, F and G are each being considered for addition to an advertising schedule comprising spots/ad showings A, B and C (col. 39 lines 2- 65 and col. 41 lines 54-57). The “plurality of hypothetical distributions” being determined are (A, B, C, D), (A, B, C, E), (A, B, C, F) and (A, B, C, G), determined from “said plurality of tasks” A, B, C, D, E, F and G. The “plurality of tasks hypothetically selected for execution” are D, E, F and G.

As to Ref. C, appellant argues that the claim is to “a singular plurality of tasks (e.g., L, M, N, and O), whereas, the Cannon reference determines scores for multiple plurality of possible tasks”. This is tantamount to arguing that the claim is to a singular apple while the reference teaching is to multiple apples. As a matter of fact, the claims are not limited to “a singular plurality of tasks”. The claims are limited to “determining a plurality of hypothetical distributions of said plurality of tasks for each task hypothetically selected for execution from said plurality of tasks. The claim is to apples and the reference teaches apples. The reference example teaches four hypothetical distributions - (A, B, C, D), (A, B, C, E), (A, B, C, F) and (A, B, C, G) – which reads on the claimed “plurality of distributions”. The reference example teaches tasks A, B, C, D, E, F and G, which reads on the claimed “plurality of tasks”. Lastly, the reference example teaches that tasks D, E, F and G are hypothetically selected for execution, which reads on the claimed “plurality of tasks hypothetically selected for execution”.

Fourth limitation of claim 1:

“selecting a first task for execution from said plurality of tasks, which when selected provides a corresponding hypothetical distribution of said plurality of tasks that is closest to said specified distribution of said plurality of tasks for implementation of said specified distribution.”

The rejection of this limitation is as follows:

“selecting a first task/*ad* for execution from said plurality of tasks/*ads* (e.g., *ad spot* task *D*), which when selected provides a corresponding hypothetical distribution (*spots A, B, C and D*, col. 39 lines 3-13) of said plurality of tasks that is closest to said specified distribution (i.e., that which maximizes the score $S_c(a)$, col. 38 lines 21-64 and col. 41 lines 57-59) of said plurality of tasks for implementation of said specified distribution.” (Para. 4 of the rejection mailed 11 August 2006)

Appellant argues,

“On the other hand, the Cannon reference does not disclose the selection of a task from a singular and unvarying plurality of tasks used to determine a specified distribution, as is recited in independent Claims 1 and 20. Instead, the Cannon reference selects a time spot from a plurality of possible time spots (e.g., spots D, E, F, and G). That is, the Cannon reference selects one combination of time spots from multiple combinations of time spots (e.g., combination of spots A, B, C, and D; combination of spots A, B, C, and E; combination of spots A, B, C, and F; and combination of spots A, B, C, and G). The selected combination provides the highest score that more efficiently matches the predetermined media objectives. (Brief p. 15, middle para. Emphasis added.)

Appellant essentially repeats the arguments made previously. There is no claim to “singular and unvarying plurality of tasks”. The rejection cites precisely where the reference teaches the claim, and the appellant has failed to specifically and distinctly point out the supposed errors in the rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 3622

For the above reasons, it is believed that the rejections should be sustained.



Respectfully submitted,

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Primary Examiner
Art Unit 3622


DONALD L. CHAMPAGNE
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6 September 2007